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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/838,675	02/21/92	FALK	PT-1039

NUTTER, N	EXAMINER
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ART UNIT	PAPER NUMBER
1503	6

DATE MAILED: 10/13/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 1 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 25 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-25 are subject to restriction or election requirement.

7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received

☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit 1503

This application repeats a substantial portion of prior application Serial No. 645,908, filed 20 May 1991, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. § 120 and 37 C.F.R. § 1.78.

Acknowledgment is made of applicant's claim for priority based on an application filed in Canada on 20 February 1992. It is noted, however, that applicant has not filed a certified copy of the Canadian Patent application as required by 35 U.S.C. § 119.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5 and 16-20, drawn to a pharmaceutical composition and "(t)ransdermal delivery of a therapeutically effective amount of a drug which prohibits prostaglandin synthesis", classified in Class 514, subclasses vary according to the particular combination claimed.

II. Claims 6-15 and 21-25, drawn to a method "of treating a disease or condition of the skin and exposed tissue" and "(u)se (sic) of a combination or formulation to treat a disease or

condition as recited, classified in Class 514, subclasses vary according to the particular combinations claimed.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as in application of cosmetics as shown by U.S. Patent No. 4,851,521 to della Valle et al or in other skin treatments and the process as claimed can be practiced with another materially different product such as steroid anti-inflammatories such as cortisone.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and as shown by their different classification restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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Art Unit 1503

A telephone call was made to Ivor M. Hughes on 28 September 1992 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication should be directed to Examiner Nathan M. Nutter at telephone number (703) 308-2351.

A handwritten signature in cursive script that reads "Nathan M. Nutter". The signature is written in dark ink and is positioned in the middle-right section of the page.

NUTTER:tce
October 07, 1992

NATHAN M. NUTTER
PATENT EXAMINER
ART UNIT 153